

REMARKS

Forty-five claims were originally filed in the present Application. Claims 1-45 currently stand rejected. Claims 1, 7, 21, and 27 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

Drawings

In paragraph 1 of the Office Action, the Examiner objects to the drawings because “they do not include the following reference sign(s) mentioned in the description” In response Applicants herein amend the Specification to remove reference to “data input 250”. In view of the foregoing remarks and amendments, Applicants believe that the Examiner’s objection is addressed, and respectfully requests that the objection to the drawings be withdrawn so that the present Application may issue in a timely manner.

Title

In paragraph 2 of the Office Action, the Examiner states that “[a] new title is required that is clearly indicative of the invention to which the claims are directed. The title should have some reference to the device’s wireless capabilities.” Applicants respectfully traverse. The Specification recites specific structure and functionality for performing data transfers by utilizing non-wireless techniques (see FIG. 6). Applicants therefore submit that amending the title to include “some reference to the device’s wireless capabilities” would unnecessarily

limit Applicants' invention. In view of the foregoing remarks, Applicants respectfully request that the objection to the title be withdrawn so that the present Application may issue in a timely manner.

35 U.S.C. § 102(e)

In paragraph 4 of the Office Action, the Examiner rejects claims 1-5, 21-25, 44, and 45 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,737,491 to Allen et al. (hereafter Allen). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Allen fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner's rejection of independent claims 1 and 21, Applicants respond to the Examiner's §102 rejection as if applied to amended independent claims 1 and 21. For example, amended independent claim 1 now recites “a transfer manager for transferring said data from said imaging device to said data destination, said transfer manager automatically transferring said data if said data stored in said data buffers exceeds a predetermined threshold amount,” which are limitations that are not taught or suggested either by the cited reference, or by the Examiner's citations thereto.

Allen teaches a camera device that transmits images to a “fulfillment server” in response to user voice commands recognized by a speech recognition system. In particular “a photographer captures the image of a scene with the digital camera 10, and verbally instructs the camera to perform one or more of the command functions listed in Table 1” (column 3, lines 49-52). In contrast, independent claims 1 and 21 affirmatively recite “automatically” performing a data transfer in response to a predetermined threshold. Applicants therefore submit that independent claims 1 and 21 are not anticipated by the teachings of Allen.

With regard to claim 45, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 as discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 45. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 45, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of Allen and Applicants’ invention as disclosed in the Specification, claim 45 is therefore not anticipated or made obvious by the teachings of Allen.

Regarding the Examiner’s rejection of dependent claims 2-5 and 22-25, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or

suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-5 and 22-25, so that these claims may issue in a timely manner.

In addition, with regard to dependent claims 5 and 25, Applicants submit that Allen nowhere teaches or suggests “data buffers being economically implemented using a reduced memory-size configuration”, as recited by Applicants in claims 5 and 25. Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Allen to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1-5, 21-25, 44, and 45, so that these claims may issue in a timely manner.

35 U.S.C. § 103

In paragraph 13 of the Office Action, the Examiner rejects claims 6, 8, 9, 12, 15-18, 26, 28, 29, 32, 37, and 38 under 35 U.S.C. § 103 as being unpatentable over Allen in view of U.S. Patent No. 6,522,352 to Strandwitz et al. (hereafter Strandwitz). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Allen according to the teachings of Strandwitz would produce the claimed invention. Applicants submit that Allen in combination with Strandwitz fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Allen nor Strandwitz contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of dependent claims 6, 8, 9, 12, 15-18, 26, 28, 29, 32, 37, and 38, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims,

when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 6, 8, 9, 12, 15-18, 26, 28, 29, 32, 37, and 38, so that these claims may issue in a timely manner.

In addition, with regard to claims 15 and 35, Applicants submit that neither Allen nor Strandwitz teach that “a controller of said data destination sends an error message to said imaging device by said wireless communications network after determining that said data and said identification information have not been successfully received, said transfer manager responsively repeating said data transfer procedure to retransmit said data from said data buffers to said data destination”, as recited by Applicants in claims 15 and 35.

For at least the foregoing reasons, the Applicants submit that claims 6, 8, 9, 12, 15-18, 26, 28, 29, 32, 37, and 38 are not unpatentable under 35 U.S.C. § 103 over Allen in view of Strandwitz, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 6, 8, 9, 12, 15-18, 26, 28, 29, 32, 37, and 38 under 35 U.S.C. § 103.

In paragraph 21 of the Office Action, the Examiner rejects claims 7 and 27 under 35 U.S.C. § 103 as being unpatentable over Allen in view of Strandwitz, and still further in view of U.S. Patent No. 5,806,005 to Hull et al. (hereafter Hull).

The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 7 and 27, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 7 and 27, so that these claims may issue in a timely manner.

In addition, with regard to claims 7 and 27, the Examiner concedes that neither Allen nor Strandwitz "describe the monitoring of buffers." Applicants concur. The Examiner then points to Hull to purportedly remedy these deficiencies. Hull teaches transmitting image data from a camera only when the camera memory is "full" (see column 3, lines 3-5). In contrast, Applicants recite initiating a data transfer operation "whenever said data stored in said data buffers reaches a predetermined threshold amount." Applicants claimed

invention is therefore not limited to initiating data transfers only when the memory is full.

For at least the foregoing reasons, the Applicants submit that claims 7 and 27 are not unpatentable under 35 U.S.C. § 103 over Allen in view of Strandwitz and Hull, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 7 and 27 under 35 U.S.C. § 103.

In paragraph 22 of the Office Action, the Examiner rejects claims 10, 13, 14, 30, and 33-36 under 35 U.S.C. § 103 as being unpatentable over Allen in view of Strandwitz, and still further in view of U.S. Patent No. 6,167,469 to Safai et al. (hereafter Safai). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 10, 13, 14, 30, and 33-36, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when

viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 10, 13, 14, 30, and 33-36, so that these claims may issue in a timely manner.

In addition, with regard to claims 10 and 30, Applicants submit that the cited references nowhere teach or disclose providing status information regarding at least one of said data transfer procedure and said arbitration procedure by using a user interface . . . ,” as recited by Applicants in claims 10 and 30. For at least the foregoing reasons, the Applicants submit that claims 10, 13, 14, 30, and 33-36 are not unpatentable under 35 U.S.C. § 103 over Allen in view of Strandwitz and Safai, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 10, 13, 14, 30, and 33-36 under 35 U.S.C. § 103.

In paragraph 27 of the Office Action, the Examiner rejects claims 11 and 31 under 35 U.S.C. § 103 as being unpatentable over Allen in view of Strandwitz, and still further in view of U.S. Patent No. 5,128,776 to Scorse et al. (hereafter Scorse). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior

art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 11 and 31, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 11 and 31, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 11 and 31 are not unpatentable under 35 U.S.C. § 103 over Allen in view of Strandwitz and Scorse, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 11 and 31 under 35 U.S.C. § 103.

In paragraph 28 of the Office Action, the Examiner rejects claim 16 under 35 U.S.C. § 103 as being unpatentable over Allen in view of Strandwitz, and still further in view of U.S. Patent No. 6,246,839 to Ichimasa et al. (hereafter Ichimasa). Similarly, in paragraph 30 of the Office Action, the Examiner rejects claim 36 under 35 U.S.C. § 103 as being unpatentable over Allen in view of

Strandwitz, Safai, and Ichimasa. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 16 and 36, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 16 and 36, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 16 and 36 are not unpatentable under 35 U.S.C. § 103 over Allen in view of Strandwitz, Safai, and Ichimasa, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 16 and 36 under 35 U.S.C. § 103.

In paragraph 29 of the Office Action, the Examiner rejects claims 19-20 and 39-40 under 35 U.S.C. § 103 as being unpatentable over Allen in view of Strandwitz, and still further in view of U.S. Patent No. 5,861,918 to Anderson et al. (hereafter Anderson). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 19-20 and 39-40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 19-20 and 39-40, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 19-20 and 39-40 are not unpatentable under 35 U.S.C. § 103 over Allen in view of Strandwitz and Anderson, and that the rejections under 35 U.S.C. § 103 are thus

improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 19-20 and 39-40 under 35 U.S.C. § 103.

In paragraph 31 of the Office Action, the Examiner rejects claim 41 under 35 U.S.C. § 103 as being unpatentable over Allen in view of U.S. Patent Publication No. US 2001/00454663 A1 to Nishizawa et al. Applicants are unable to adequately respond to the rejection of claim 41 because the Nishikawa reference cited by the Examiner is apparently actually to Madding et al. Applicants therefore request the Examiner to clarify whether the inventor information or the U.S. Patent Publication No. is misstated in the current Office Action with respect to the rejection of claim 41.

In paragraph 32 of the Office Action, the Examiner rejects claim 42 under 35 U.S.C. § 103 as being unpatentable over Allen in view of Safai. The Applicant respectfully traverses this rejection for at least the following reasons. Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 42, for at least the reasons that this claims is directly or indirectly dependent from an independent claims whose limitations are not identically taught or suggested, the limitations of

this dependent claim, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claim 42, so that this claim may issue in a timely manner.

In addition, in the rejection of claim 42, the Examiner states that “[i]t would have been obvious . . . to create formats on a camera . . . ,” as support for the rejection without providing a specific reference to support the claimed “conversion software module”. It appears that the Examiner is utilizing Official Notice without expressly stating so. Applicants therefore respectfully request the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claim 42 so that the present Application may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claim 42 is not unpatentable under 35 U.S.C. § 103 over Allen in view of Safai, and that the rejection under 35 U.S.C. § 103 is thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 42 under 35 U.S.C. § 103.

In paragraph 33 of the Office Action, the Examiner rejects claim 43 under 35 U.S.C. § 103 as being unpatentable over Allen in view of Hull. The Applicant respectfully traverses this rejection for at least the following reasons. Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of

obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 43, for at least the reasons that this claim is directly or indirectly dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of this dependent claim, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claim 43, so that this claim may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claim 43 is not unpatentable under 35 U.S.C. § 103 over Allen in view of Hull, and that the rejection under 35 U.S.C. § 103 is thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 43 under 35 U.S.C. § 103.

Combination Of Multiple References Under 35 U.S.C. § 103(a)

The Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987).

Applicants note that the Examiner currently relies on a combination of one primary reference and seven (7) additional secondary references in ten (10) separate grounds of rejection to reject all Applicants' claims under either 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a). With regard to the rejections under 35 U.S.C. § 103(a), Applicants respectfully submit that providing proper motivation to combine each cited reference with the *substantial number* of other cited references has not been adequately provided, and therefore the rejections under 35 U.S.C. § 103(a) are improper.

Applicants further suggest that requiring such an excessively large number of references to support the rejections may reasonably be viewed as evidence of *non-obviousness*, since any teaching or suggestion to combine all eight references becomes increasingly remote as the number of cited references increases. 35 U.S.C. §103 requires that an invention be considered "as a whole" when determining if the invention is obvious in relation to prior art. All elements of the claimed invention must be taken into consideration. Focusing on the obviousness of substitutions and differences, instead of the invention as a whole, is a legally improper way to simplify the difficult determination of obviousness. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d, 1367, 231 USPQ 81 (Fed. Cir. 1986); cert den., 480 U.S. 947 (1987).

In addition, the Examiner repeatedly refers to various beneficial aspects of Applicants' invention as purported motivation to combine the cited references. Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention

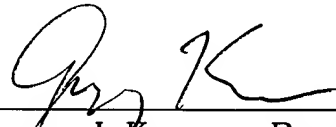
cannot act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's objections and rejections. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-45 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: 12/29/04

By: 
Gregory J. Koerner, Reg. No. 38,519
Redwood Patent Law
1291 East Hillsdale Blvd., Suite 205
Foster City, CA 94404
Tel: (650) 358-4000